

Reconsideration of the rejection of claim 1 under 35 U.S.C. 112, second paragraph made in paragraph 3 of DETAILED ACTION is respectfully requested for the reasons which follow.

In claim 1 it is intended to identify a source of a connector which is part of the invention; there is no intent to add a structural limitation of the source-identified connector to the claim. The source is the manufacturer that sells a VELCO-identified connector which, as supplied by the source, comes in two varieties, one that has “hooks” and one that has “loops.” In use, the “hooks” and “loops” engage with each other to establish a connection.

The claim in effect thus specifies first two varieties of connector that should be obtained from the source using the mark VELCRO by which it identifies itself. The source-identifying function of the mark VELCRO is preserved because it is spelled in all capital letters and is followed by a generic designation, namely, “hook-type fastener” and “loop-type fastener,” as prescribed by MPEP 608.01(v).

How these varieties of connectors obtained from the trademark user source are used is an essential aspect of the invention and is set forth in the claim. Involved is a brassiere that supports a user’s breasts, and the user is given two options. In one option an underwire is connected about the bottom of the breast and provides maximum support. The tradeoff however is that the underwire, because it is rigid, is a source of discomfort.

The other option is to disconnect the underwire. This provides only minimal support, but results in maximum comfort because the source of the discomfort has been removed.

The connection of the two varieties of the connectors obtained from the VELCRO-identified source is made on the back side of the brassiere, namely, that side which contacts the sensitive skin area surrounding the breasts. If the VELCRO hook-type connector is

the variety used on the back of the brassiere when the underwire is removed, the "hook" ends of the connector remaining on the brassiere, which of course is what happens because there is no removal thereof, will stick into the sensitive skin area noted and be an unacceptable source of discomfort.

Thus, it is an essential aspect of the invention that the purchased VELCRO loop-type connector be used on the back of the brassiere because the removal of the underwire exposes the closed ends or loops of this connector which, because they are not of a skin-sticking nature, are not a source of discomfort.

When the underwire is left in place , there is no problem because the two purchased varieties from the source identified by its trademark VELCRO are in face-to-face contact with each other, and neither loop nor hook ends are in contact with the noted sensitive skin area.

In summary of the foregoing and, as explained at application page 2, in lines 14-19, the word VELCRO is not used to add a structural limitation in the claim, but to provide source identification of the supplier of claimed structure to practice the invention and is the proper and only practical way in which the invention is enabled. After the term of the patent, it cannot be expected that one desiring to derive the benefit of the claimed technology would build and operate what is necessary to have hook-type and loop-type connectors. It is both possible and expected however that VELCRO-identified hook-type and loop-type connectors would be readily commercially available and ordered by the trademark VELCRO to practice the invention which passes into the public domain upon the end of the term of any patent granted on this application.

For the foregoing reasons the rejection based on use of the trademark VELCRO in claim 1 should be withdrawn.

Reconsideration is also requested of the indefiniteness attributed to the phraseology used in claim 1.

It is not believed that application has exceeded the discretion that is afforded to him in the manner in which the invention is defined and presented for consideration.

More particularly, as provided in MPEP 2173.01 CLAIM TERMINOLOGY:

"A fundamental principal contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought."

The invention is pinpointed at application page 1, bottom paragraph, and the reference to "optional first and second uses" in claim 1, line 1, should be clear as to their reference. A first option is defined in claim 1, in lines 11, 12, and a second option in lines 13-15.

Applicant has elected to describe the invention as "a construction for optional first and second uses of... breast cup supports [i.e., the underwires 38] for a brassiere" (the underlining added for emphases to the letter "a" in line 2). This description is not one that is used in a way that is contrary to accepted meanings in the art. Also preceding the word brassiere with the letter "a" provides an antecedent basis for the references to "said brassiere" in subsequent lines in the claim.

The reference to “an operative location” describes a position of a VELCRO loop-type fastener, namely in the location described in claim 1, in lines 8-10, the word “operative” having the definition No. 6 provided in WEBSTER’S COLLEGE DICTIONARY.

For the foregoing reasons, the rejection of claim 1 attributed to indefiniteness of language should be withdrawn.

Reconsideration is respectfully requested for the rejection of claim 1 as unpatentable under 35 U.S.C. 103(a) over Fairbanks et al.

The examiner argues that the use of the metal male shapes 26 and cooperating female snaps 21 in Fairbanks et al. suggests the use of applicant’s VELCRO hook and loop connectors, and that such substitution by applicant was obvious. Applicant’s invention however is not merely the attaching and the detaching of the brassiere cup underwire or support, but rather the wearing of the brassiere with the underwire attached, i.e., one option, and, equally important, wearing the brassiere (underlining added for emphasis), with the underwire detached, i.e., the other option.

In Fairbanks et al., there are no such two options, but only the one option, namely, the wearing of the brassiere with the underwire attached. When the underwire is detached, according to Fairbanks, et al., the brassiere is not worn, but the detached underwire is then in condition to facilitate the brassiere being laundered, the wire being removed from its sheath so that “the brassiere may be laundered without damaging the wire” (at column 2, lines 43-45). The examiner thus goes beyond the disclosure of Fairbanks et al. and attributes to this reference a use which is not intended and, accordingly, not obvious from the one use that is disclosed.

In fact, from the disclosed use of Fairbanks et al., the reader is led away from the full extent of the use of a VELCRO-attached underwire as disclosed and claimed by applicant.

Whether the Fairbanks et al. remaining connector after the underwire is detached preparatory to laundering is the male snap or the female snap, in either case it is a component of a nature which, when in contact with the wearer's chest area about her breast, would be a source of discomfort.

In contrast, applicant has recognized that the version of the VELCRO connector which is constituted of loops, is one in which each free end of a loop is "closed" or devoid of a sticking pointed end, as is not the case with the hook version, and thus the specifying of the loop-type version on the brassiere is an enablement of the two-option concept, and is a concept that is not possible using a snap connection of metal male and female components, as taught by Fairbanks et al.

As to the distinctively different methods of establishing a connection of the underwire to the brassiere and, more particularly, the asserted obviousness of one for the other, the test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

The examiner stresses the "greater ease" in fastening and unfastening the components involved together and, based thereon, argues presumably that since snaps and

adhesives, also mentioned, have the requisite "greater ease" possessed by applicant's VELCRO connectors, that the substitution could be made. The fact that the snap structure could be modified does not make such a modification obvious in the absence of the cited patent suggesting the desirability of doing so. (In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 984)). Here, the examiner has provided no clue as to where support is found for the reasoning that the nature of the connection can go beyond attaching two parts together and can significantly affect the end use of the article embodying the two or one of the parts, and thus what the examiner suggests as obvious stands merely as the examiner's unsupported opinion. Applicant finds no support for this opinion in the prior art of using "snaps and/or adhesives" or expressed in the cited reference, and it thus would appear that the only motivation for doing so is found in the hindsight afforded one who first viewed the applicant's disclosure. This, of course, is not a proper basis for a rejection under Section 103.

Another ground for withdrawing the rejection is the failure of the examiner to apply In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) and, more particularly, the holding therein that on the issue of anticipation all limitations of a claim must be considered, i.e., the reference to the proposition "the name of the game is the claim," which appears on the cited page of Hiniker.

For the foregoing reasons, the rejection of claim 1 should be withdrawn.

Favorable reconsideration of this application is respectfully requested.

Respectfully,

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